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Attorney Docket: 112.P55017

SEP 29 2006

REMARKS

Claims 1-20 are pending in the above-referenced patent application. In this response, claims 1, 3, 5, 7-11, 13, 15 and 17-19 have been amended, and no claims have been added or cancelled. Claims were amended to more clearly delineate intended subject matter. Furthermore, it is believed that these amendments do not narrow claim scope. Rather, in some circumstances, the claim scope may even be broadened. As a result, no prosecution history estoppel should result from these claim amendments.

Allowable Subject Matter

The Examiner indicated that claims 18 and 19 would be allowable if rewritten in independent form. Assignee has amended claim 10 to include limitations directed to at least some of the subject matter claim 18 which Examiner deemed allowable. Accordingly, Assignee respectfully submits that claims 10-20 are now in a condition for allowance and requests that Examiner withdraw the rejections of claims 10-17 and 20 and the objections to claims 18 and 19.

Claim Rejections – 35 USC §112

In the Office Action, dated July 3, 2006, the Examiner rejected claims 1-5 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. This rejection is respectfully traversed. It is respectfully submitted that claims 1-5 do particularly point out and distinctly claim the subject matter which the applicant regards as the invention, in accordance with 35 USC 112, second paragraph. For example, the limitation "preliminary range" noted by the Examiner is sufficiently definite. One skilled in the art would be able to refer at least to figure 4 and the supporting portions of the specification to ascertain examples of a "preliminary range". For example, although the claimed subject matter is not limited in this respect, quoting from page 4, line 27 to page 5, line 2, "First, in step A, a preliminary range 1 of scanning is located. The preliminary range 1 is determined from the rim toward the center of the scanner window 10. The preliminary range 1 is an area covering the illuminator 21 and the

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document D located within the scanner window 10." Additionally, it is well-established that an applicant is entitled to be his own lexicographer. Quoting from MPEP 2173.01, "A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification." Accordingly, it is respectfully submitted that the limitation "preliminary range" would be sufficiently clear and definite to one skilled in the relevant art, and, additionally, at least one example of a preliminary range is clearly set forth in the specification. It is, therefore, respectfully requested that the Examiner withdraw these rejections of claims 1-5.

Claim Rejections – 35 U.S.C §102(e)

In the Office Action, the Examiner rejected claims 1-10, 12-17 and 20 under 35 USC 102(e) as being anticipated by Cook (US Pat. No. 6,271,935). This rejection is respectfully traversed. Assignee respectfully submits that Cook does not show or describe each and every element of the rejected claims, as required by 35 U.S.C. 102(e), and, therefore, contrary to the Examiner's assertion, the claims are not anticipated by Cook.

As just an example, referring to claim 1, Cook does not show or describe at least "obtaining a pre-scanned image from a scanner, wherein the pre-scanned image includes a document image portion and a background image portion, the background image portion comprising at least two color regions; determining a preliminary range of the pre-scanned image; distinguishing at least a portion of said document image portion from said at least two color regions of said background image portion; and determining a position of the document image portion within the range of the pre-scanned image." Cook is directed toward blanking an image in order to mask scanning artifacts. Cook does not show or describe "distinguishing at least a portion of said document image portion from said at least two color regions" but, rather, the cited portions of Cook describe identifying start and end lines of an image. See, for example, col 5:18 – col 5:35. Cook does not distinguish a document image portion from at least two color regions.

Accordingly, because Cook fails to show or describe each and every element of the rejected claims, a sufficient showing of anticipation has not been established, and claim 1 is in condition for allowance. Additionally, claims 2-9 depend from and include all limitations of claim 1, and are in a condition for allowance for at least the same reasons.

Additionally, as noted above, claim 10 has been amended to include limitations directed to at least some subject matter of claim 18 which was deemed allowable. For example, claim 10 now includes the limitation, "the pre-scanned image comprising at least a portion of the document, at least a portion of the illuminator and at least a portion of the scanner cover". Accordingly, because claim 10 includes limitations of claim 18, which the Examiner indicated would be allowable if rewritten in independent form, it is respectfully submitted that claims 10-20 are now in a condition for allowance.

Claim Rejections – 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 11 under 35 USC 103(a) as being unpatentable over Cook. This rejection is respectfully traversed.

The Examiner states "disposing an illumination source on the scanner cover is well known and routinely implemented in the art". This assertion of what is "well known" is respectfully traversed. In accordance with the Manual for Patent Examining Procedure (MPEP) §2144.03, Assignee respectfully requests that the Examiner either provide documentary evidence of the assertions that these limitations are well known in accordance with MPEP §2144.03, or withdraw the assertion of what is "well known."

However, it is respectfully submitted that Cook, whether viewed alone or in combination with what the Examiner alleges is "well known", does not teach or suggest every limitation of claim 11, and, therefore, a sufficient case of *prima facie* obviousness has not been established. It is noted that in order to establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings, and the combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be

some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that the cited references do not meet these criteria. For example, the prior art reference does not teach or suggest all the claim limitations.

As just an example, Cook does not teach or suggest at least a scanner adapted to "obtain a pre-scanned image, the pre-scanned image comprising at least a portion of the document, at least a portion of the illuminator and at least a portion of the scanner cover; determine a preliminary range of the pre-scanned image; distinguish at least a portion of the pre-scanned image comprising said portion of the document from at least a portion of the image comprising said portion of the scanner cover and said portion of the illuminator". As mentioned previously, Cook describes identifying start and end lines of the image. Cook does not show or describe a scanner adapted to "distinguish at least a portion of the pre-scanned image comprising said portion of the document from at least a portion of the image comprising said portion of the scanner cover and said portion of the illuminator".

It is respectfully submitted, therefore, that for at least the reasons presented above, a *prima facie* case of obviousness under section 103 of the patent statute has not been made. For example, even if a successful combination were made of Cook with what the Examiner alleges as "well-known", the resultant combination would still not teach or suggest all the claim limitations. It is noted that many other bases for traversing the rejections set forth above could be provided, but Assignee believes that the presented grounds are sufficient. It is respectfully requested that the Examiner withdraw his rejection of claim 11, and allow claim 11 to proceed to allowance.

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CONCLUSION

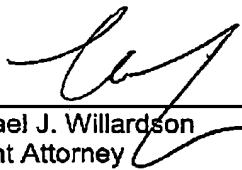
In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: _____

9/29/06




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I hereby certify that this correspondence is being submitted via facsimile or deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

September 29, 2006
Date of Transmission

Leslie C. Mullican
Name of Person Transmitting Correspondence

Signature